

### REMARKS

The present application relates to hybrid maize plant and seed 34B97. Claims 5-8, 20, 44-54, 56-57, 60-63 and 66 have been canceled. Claims 55, 58-59, and 64-65 were previously canceled in the Preliminary Amendment submitted on July 21, 2003 and claims 9-19 and 21-43 were previously canceled in the Amendment submitted March 11, 2003. Claims 1 and 2 have been amended. Claims 67-80 have been added at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

#### Detailed Action

##### *A. Status of the Application*

Applicant acknowledges the finality of the previous Office Action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant further acknowledges that the objection to the specification for the presence of blank lines on page 7 is withdrawn. Applicant also acknowledges that the rejection of claims 45-51, 59, and 64 under 35 U.S.C. § 112, second paragraph is withdrawn. Applicant acknowledges that the rejection of claims 44-51, 56, 57, and 59 under 35 U.S.C. § 112, first paragraph is withdrawn. Applicant further acknowledges that the rejection of claims 48-51 under 35 U.S.C. § 112, first paragraph is withdrawn. Applicant further acknowledges that the rejection of claims 58 and 59 under 35 U.S.C. § 112, first paragraph is withdrawn. In addition, Applicant has amended the specification to clarify the deposit language and remove the blank lines by adding the appropriate ATCC Accession Nos. A copy of the ATCC deposit receipts is included in this response. No new matter has been added.

##### *B. Election/Restrictions*

The Examiner states that claims 44-51, 57, and 66, Group II, are directed to an invention that is independent or distinct from the invention originally claimed. The Examiner further states Group I, claims 1-8, 20, 52-54, 56, and 60-63 are directed to hybrid maize seed designated 34B97; a maize plant or its parts produced from said seed; a tissue culture of regenerable cells of said plant; a maize plant regenerated from said tissue culture; said maize plant further comprising an introgressed cytoplasmic gene that confers male sterility; said hybrid maize plant wherein the

genetic material contains one or more mutant genes or transgenes; a method of making hybrid maize plant 34B97 comprising crossing inbred maize plants GE533003 and GE567919; a method of producing a male sterile maize plant comprising transforming 34B97 with a transgene conferring male sterility, classified in class 800, subclass 320.1. The Examiner states Group II, claims 44-51, 57, and 66 are directed to methods of developing a transgenic 34B97 maize plant, comprising transforming at least one of the inbred parents of 34B97 with a transgene; or a method of developing a backcross conversion of 34B97 hybrid maize plant, comprising backcrossing a mutant gene or transgene into at least one of two inbred maize plants; a maize plant produced by said methods; a process for isolating an inbred corn plant, classified in class 800, subclass 260. Applicant respectfully submits that the Examiner intended claim 57 for Group II. The Examiner states that since Applicant has received an action on the merits for the originally presented invention, Group I, this invention has been constructively elected by original prosecution for prosecution on the merits. The Examiner accordingly withdraws claims 44-51, 57 and 66 from consideration as being directed to a non-elected invention. (37 C.F.R. § 1.142(b)). See MPEP § 821.03.

Applicant respectfully submits that the election of Group I, claims 1-8, 20, 52-54, 56, and 60-63 is made **with traverse**. Applicant further submits that claims 44-51, 57 and 66 have been canceled. However, claims 67-80 have been added at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003.

### *C. Claim Objections*

Claims 20 and 52 are objected to under 37 C.F.R. § 1.75(b) as being duplicate claims. Applicant has canceled claims 20 and 52, thereby alleviating this rejection.

### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claim 8 remains rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has canceled claim 8, thus alleviating this rejection.

Claim 7 stands rejected as indefinite for the recitation "capable of expressing".

Applicant has now canceled claim 8, thereby alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 60-63 remain rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record in the Office Action mailed May 19, 2003.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 60-63, thus alleviating this rejection. Applicant has added new claims 67-80 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully submits the claims now come within the purview of the written description requirement and request reconsideration.

Claim 8 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner further states that the specification does not describe hybrid maize seed 34B97 as comprising a cytoplasmic gene that confers male sterility and that there is no description of how a gene can be introgressed into any hybrid corn plant.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claim 8, thereby alleviating this rejection. Applicant has added new claims 67-80 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully submits the claims now come within the purview of the written description requirement and request reconsideration.

Claim 8 stands rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

art to which it pertains, or with which it is more nearly connected, to make and/or use the invention.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claim 8, alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 8 and 60-63 under 35 U.S.C. § 112, first paragraph.

### Summary

Applicant acknowledges that claims 1-6, 53, 54 and 56 are allowed.

Applicant further acknowledges that claims 67-80 have been agreed upon as allowable by Supervisory Patent Examiner Amy Nelson as aforementioned, thereby placing these claims in form for allowance. Applicant has canceled all non-allowable claims thereby placing the application in condition for allowance and has complied with all requirements of form set forth in previous office actions.

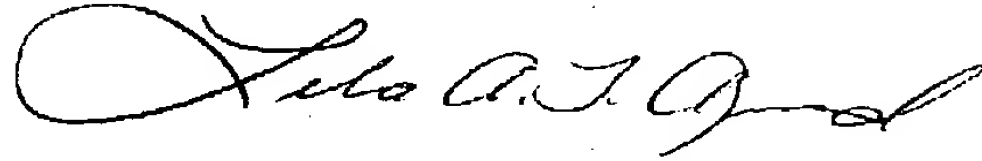
### Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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